

### **Remarks**

Claims 1 - 14 and 21 – 25 remain in the application, and claims 15 – 20 were previously cancelled. This transmittal is presented in response to the fourth office action and is believed to completely resolve each issue as raised by the examiner. Applicant believes the claims as amended to be non-obvious and patentably distinct from all prior art.

#### **OA Item #1: Claim 4 Rejected - Lack of Antecedent Basis:**

Claim 4 has been amended to add language to provide an antecedent.

#### **OA Item #2: Claims 1-14 Rejected under 35 USC § 112, 1<sup>st</sup> para - new matter:**

The examiner has rejected claims 1 – 14 under 35 USC § 112, first paragraph, arguing that the use of the phrase “flowable” constitutes new matter. The applicants respectfully disagree with and traverse the examiner’s rejection. Although applicants’ reasons are fully set forth in a previous office action, to assure applicants’ position is clearly understood, applicants reassert their position in this office action response. Applicants respectfully suggest that the examiner has inappropriately applied a new matter rejection. For new matter to exist, an applicant must add something to the specification, especially to the claims, that is not supported by an applicant’s original disclosure. In the current application, there is no matter that does not find support in the applicant’s original disclosure. For instance, the term “flowable” finds support in the original disclosure by virtue of the description of the candy powder that is described as being contained in the container regardless of the orientation of the container due to the candy powder “flowing” to the lower side of the container. Inasmuch as the disclosed candy powder exhibits the property of flow, the candy powder is a “flowable” substance. However, the examiner asserts that new matter exists in applicants’ application not because there was not support for the matter in the original disclosure, but rather because applicants’ claim language, in addition to describing matter disclosed in applicants’ disclosure, may also describe matter that was not specifically disclosed in applicants’ original disclosure. Applicants’ respectfully suggest that such determination is wrong. That applicants’ claim language may also describe matter not specifically disclosed in applicants’ original disclosure is of no consequence so long as applicants’ claim language

is supported by applicants' original disclosure. Such type of claiming has been and is the hallmark of rigorous patent prosecution. The US patent office's files are replete with issued patents that include claims having claim language broad enough to not only cover subject matter specifically disclosed in their respective specifications, but also broad enough to cover subject matter not specifically disclosed in their respective specifications. Should for instance the examiner's test for new matter be applied to all issued patents, it is likely that a large majority of them would stand rejected (inappropriately) due to new matter. Having pointed out the error in rejection, the applicants' respectfully request that the examiner withdraw the new matter rejection.

**OA Item #3: Claims 1-14 and 21-25 Rejected under Obvious Type Double Patenting:**

The examiner has rejected claims 1 – 14 and 21 – 25 under obvious type double patenting over claims 1 – 9 of US patent 5,246,046 and claims 1 – 11 of US patent RE36,131 in view of Hunter (GB '356), Martindale ('797), Coleman ('884) and Hoeting et al ('870). The examiner has also rejected claims 1 – 14 and 21 – 25 under obvious type double patenting over claims 1 – 29 of US patent 6,386,138 in view of Hunter (GB '356), Martindale ('797), Coleman ('884) and Hoeting et al ('870). The applicants respectfully traverse the examiner's rejection on the basis that the applicants' invention in the appended modified claims is substantially different than the cited prior art patents of the applicant and on the basis of negative teachings by the cited patents.

Substantially Different: The applicants urge that the teachings of '046 and '131 are far removed from that of the amended claims of the current application. Applicants note that '046 and '131 were directed toward resisting the spillage of liquid bubble solution whereas applicants' current application is directed towards resisting the spillage of candy powder or candy beads or the like while having an open container access so as to be able to coat a lollipop type confection with the candy powder or candy beads. The successful creation of a product that allows the user to readily coat a lollipop type confection with candy powder or the like without having the burden of opening and closing a lid or other perform some other cumbersome process creates a heretofore unknown and nonobvious product. Thus the difference between the prior patents and the current application is greater than merely a recitation that the container now contains edible matter. The examiner states that, "the differences are

substantially in the content of the container”. The applicants readily agree that there are substantial differences in the contents of the current inventive container and the containers of the previous inventions. The applicants urge that such difference in container contents contributes to the patentability of the subject invention. While the examiner may not perceive the container contents as contributing to patentability and non-obviousness, clearly, this is not a position universally held by the office. To confirm this, one need look no further than applicants’ own cited prior invention. US patent application 09/287,798, which is directed to a spill proof Easter egg coloring container and which during the prosecution of the subject application has matured into US patent 6,386,138, was allowed in part due to the unique matter contained within the container (e.g. an egg shaped edible article). See for instance independent claims 10 and 20.

Negative Teaching: The applicants respectfully disagree with the examiner and urge that the Coleman and Hoeting art provide negative teachings. The applicants respectfully suggest that the negative teaches needn’t be limited to what is claimed but may be found elsewhere in the specification. As noted in the applicant’s previous office action response, both Coleman and Hoeting recognized the problem of spillage of candy particulate and both attempt to address the problem in their respective inventions. It is also acknowledged that Coleman does provide a candy particulate container having a degree of spill resistivity. However, in as much as Coleman stores the lollipop product outside of the particulate containing compartment of the container, the container must be opened to access the particulate with the lollipop. By opening the Coleman container, the container is then of course rendered highly spillable much like any open-mouthed conventional container.

In an apparent effort to overcome this loss of spill resistivity, Hoeting redesigned his disclosed invention to place both the lollipop product and the particulate candy within the same “spill resistant” closed container. And as with Coleman, so long as the Hoeting container remains closed, the Hoeting container is spill resistant. And as with Coleman, in order to use the Hoeting container, the Hoeting container must be opened, rendering Hoeting highly spillable. However, in spite of having access to Hunter and Martindale, not only have Coleman and Hoeting put forth edible particulate containers lacking the very funnel that could have solved the recognized problem, Hoeting introduced a new problem. The Hoeting product is analogous to an unassuming person holding a convention cup of

coffee and wearing a wristwatch. When the person is asked what time it is, the person responds by turning his wrist to observe the face of his watch, only to spill his coffee from his cup. Likewise, because Hoeting placed the lollipop inside of the container with the candy particulate, it is a natural tendency for a user of the Hoeting product to spill the candy particulate when rotating the Hoeting container into a position to access the lollipop. In conclusion, Coleman and Hoeting, in spite of Hunter, Martindale, and all other prior art, have taught inventions that do not solve their own recognized problem of spill resistance of accessible particulate candy. The applicant's suggest that if their invention was obvious to one having ordinary skill in the art, then inventors such as Coleman and Hoeting who had access to art having containers with funnels, would have solved the problem as the applicants have done. Instead, in spite of the long felt need, other inventors such as Coleman and Hoeting have not invented the applicant's invention and Coleman and Hoeting have negatively taught spill resistance of particulate candy with convention non-funneled containers that are in fact highly spillable.

In conclusion, the Applicants suggest that the spill resistant candy container is no more obvious in light of powder containers having funnels and candy powder containers than either the spill resistant bubble solution container was in light of bubble solution containers with a version of a funnel and spill resistant liquid containers or than was . Given the substantially different invention, and the negative teaching, it is urged that an "obvious" rejection is not proper and it is respectfully requested that the examiner withdraw the rejection.

**OA Item #4: Claims Rejection under 35 USC § 103(a) - Obviousness:**

The examiner has rejected claims 1 – 14 and 21 – 25 under 35 USC § 103(a) based on Hunter (GB '356) in view of Schramm ('046) and Martindale ('797) and Coleman ('884)/Hoeting et al ('870). The applicants respectfully traverse the examiner's rejection on the basis that the applicants' invention in the appended modified claims is substantially different than the cited prior art patents of the applicant and on the basis of negative teachings by the cited patents.

Substantially Different: The applicants urge that the teachings of '046 and '131 are far removed from that of the amended claims of the current application. Applicants note that '046 and '131 were

directed toward resisting the spillage of liquid bubble solution whereas applicants' current application is directed towards resisting the spillage of candy powder or candy beads or the like while having an open container access so as to be able to coat a lollipop type confection with the candy powder or candy beads. The successful creation of a product that allows the user to readily coat a lollipop type confection with candy powder or the like without having the burden of opening and closing a lid or other perform some other cumbersome process creates a heretofore unknown and nonobvious product. Thus the difference between the prior patents and the current application is greater than merely a recitation that the container now contains edible matter. The examiner states that, "the differences are substantially in the content of the container". The applicants readily agree that there are substantial differences in the contents of the current inventive container and the containers of the previous inventions. The applicants urge that such difference in container contents contributes to the patentability of the subject invention. While the examiner may not perceive the container contents as contributing to patentability and non-obviousness, clearly, this is not a position universally held by the office. To confirm this, one need look no further than applicants' own cited prior invention. US patent application 09/287,798, which is directed to a spill proof Easter egg coloring container and which during the prosecution of the subject application has matured into US patent 6,386,138, was allowed in part due to the unique matter contained within the container (e.g. an egg shaped edible article). See for instance independent claims 10 and 20.

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In an apparent effort to overcome this loss of spill resistivity, Hoeting redesigned his disclosed invention to place both the lollipop product and the particulate candy within the same “spill resistant” closed container. And as with Coleman, so long as the Hoeting container remains closed, the Hoeting container is spill resistant. And as with Coleman, in order to use the Hoeting container, the Hoeting container must be opened, rendering Hoeting highly spillable. However, in spite of having access to Hunter and Martindale, not only have Coleman and Hoeting put forth edible particulate containers lacking the very funnel that could have solved the recognized problem, Hoeting introduced a new problem. The Hoeting product is analogous to an unassuming person holding a convention cup of coffee and wearing a wristwatch. When the person is asked what time it is, the person responds by turning his wrist to observe the face of his watch, only to spill his coffee from his cup. Likewise, because Hoeting placed the lollipop inside of the container with the candy particulate, it is a natural tendency for a user of the Hoeting product to spill the candy particulate when rotating the Hoeting container into a position to access the lollipop. In conclusion, Coleman and Hoeting, in spite of Hunter, Martindale, and all other prior art, have taught inventions that do not solve their own recognized problem of spill resistance of accessible particulate candy. The applicant’s suggest that if their invention was obvious to one having ordinary skill in the art, then inventors such as Coleman and Hoeting who had access to art having containers with funnels, would have solved the problem as the applicants have done. Instead, in spite of the long felt need, other inventors such as Coleman and Hoeting have not invented the applicant’s invention and Coleman and Hoeting have negatively taught spill resistance of particulate candy with convention non-funneled containers that are in fact highly spillable.

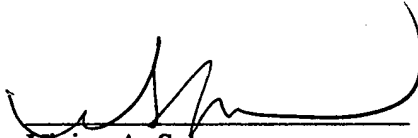
In conclusion, the Applicants suggest that the spill resistant candy container is no more obvious in light of powder containers having funnels and candy powder containers than either the spill resistant bubble solution container was in light of bubble solution containers with a version of a funnel and spill resistant liquid containers or than was . Given the substantially different invention, and the negative teaching, it is urged that an “obvious” rejection is not proper and it is respectfully requested that the examiner withdraw the rejection.

**Conclusion:**

Applicants submit that the amendments to the claims and the arguments presented herein have established the claims to be in condition for allowance. Action in accordance therewith is earnestly solicited.

If the examiner has any questions or comments which may be resolved over the telephone, he is requested to call Michael R. Schramm at 801-625-9268 (wk) or at 435-734-2599 (hm).

DATE: September 6, 2005    Respectfully submitted,

  
Vivian A. Schramm

  
Michael R. Schramm